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09/703,503	10/31/2000	Anders Borgstrom	34650-569PT	2935

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EXAMINER

LE, DANH C

ART UNIT

PAPER NUMBER

2683

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/703,503

Applicant(s)

BORGSTROM ET AL.

Examiner

DANH C LE

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-8,13-20,26,27,30 and 31 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.

- 6) ☒ Claim(s) 1-3,5-8,13-20,26,27,30 and 31 is/are rejected.

- 7) ☐ Claim(s) _____ is/are objected to.

- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-3,5,6,13-16, 18-19, 26-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Challa (US 6,396,481).

As to claim 1, Challa teaches the system for controlling an electronic device (figure 1 and 12), comprising:

an electronic device (10), said electronic device including a display screen (30, 1104);

a specially formatted surface; including a predefined, address pattern and further including at least one field for use in performing a control function with respect to a display on the display screen of on the electronic device (col.3, line 64-col.4, line 26); and

an address pattern reading device for detecting a portion of the predefined address pattern adjacent to the reading device, wherein a position of the reading device on the specially formatted surface can be determined using the detected portion of the predefined address pattern, and wherein a position of the reading

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device with respect to the at least one field controls the display on the display screen of the electronic device (col.8, line 34-col.9, line 56).

As to claim 2, Challa teaches the system of claim 1, wherein the electronic device includes the reading device (60).

As to claim 3, Challa teaches the system of claim 1, wherein the reading device comprises an electronic pen separate from the electronic device (50).

As to claim 5, Challa teaches the system of claim 1, wherein the specially formatted surface comprises a paper, and wherein said at least one field comprises having a plurality of fields for performing a plurality of control functions with respect to the display on the display screen of the electronic device (col.3, line 64-col.4, line 26).

As to claim 6, Challa teaches the system of claim 1, wherein the specially formatted surface and the reading device comprise at least a portion of a man-machine interface for the electronic device (col.5, line 44-col.6, line 17).

As to claim 13, Challa teaches the system of claim 1, wherein the reading device includes a transmitter for communicating with the electronic device (figure 3, 242).

As to claim 14, Challa teaches the system of claim 13, wherein the transmitter transmits information to the electronic device via at least one of a cable and a local wireless link (col.3, line 50-col.4, line 39).

As to claim 15, Challa teach the system of claim 13, wherein the transmitter operates in accordance with Bluetooth radio interface technology (col.6, lines 19-42).

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As to claim 16, Challa teaches the system of claim 1, wherein the electronic device is selected from the group consisting of a mobile phone, a computer, a personal digital assistant, a calculator, a game console, a television, and a digital camera (abstract).

As to claim 18, the claim is a method claim of claim 1; therefore, the claim is interpreted and rejected as forth in the claim 1.

As to claim 19, the claim is a method claim of claim 5; therefore, the claim is interpreted and rejected as forth in the claim 5.

As to claim 26, the claim is a method claim of claim 8; therefore, the claim is interpreted and rejected as forth in the claim 8.

As to claim 27, Challa teaches the method of claim 26, wherein the selection is detected by sensing a pressure on the reading device (col.4, lines 3-11 and col.5, lines 13-42).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

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Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 7, 8, 17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Challa in view of Merkel (US 5,739,810).

As to claim 7, Challa teaches the system of claim 1, wherein the at least one field comprises a navigation field and wherein the display on the display screen. Challa fails to teach the displaying includes a cursor, wherein a position of the reading device with respect to the navigation field controls the position of the cursor on the display screen. Merkel teaches the displaying includes a cursor, wherein a position of the reading device with respect to the navigation field controls the position of the cursor on the display screen (col.3, lines 11-42). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Merkel into the system of Challa in order to control the position on the screen of the portable handwriting capture.

As to claim 8, the combine of Challa and Merkel teaches the system of claim 7, wherein a current position of the cursor is performed by a selection function (Merkel, col.3, lines 11-42), the selection function selected from the group consisting of a detection by the reading device of a portion of the address pattern within a selection field on the specially formatted surface, and a pressure

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sensitive detection on the reading device (col.4, lines 3-11 and col.5, lines 13-42).

As to claim 17, the combine of Challa and Merkel further teaches the system of claim 1, wherein the at least one field includes a field for providing the reading device with a joystick functionality (Merkel, col.3, lines 11-42).

As to claim 20, the claim is a method claim of claim 7; therefore, the claim is interpreted and rejected as forth in the claim 7.

3. Claims 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Challa in view of Kushita(US 6,118,436).

As to claim 30 and 31, Challa teaches the method of claim 18. Kushita fails to teach further comprising the step of translating the at least one detected portion of the address pattern into a rotation angle or a tilt angle. Kushita teaches comprising the step of translating the at least one detected portion of the address pattern into a rotation angle or a tilt angle (col.5, lines 27-43 and col.7, lines 54-65). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Kushita into the system of Challa in order to control input on the screen of the portable handwriting capture.

Response to Arguments

Applicant's arguments with respect to claims 1-3, 5-8, 13-20, 25-27, 30, 31 have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A. Pettersson et al (US 6,548,768) teaches the determination of a position code.

B. Hulick et al (US 6,462,941) teaches the method and apparatus for backlight a handwriting input area for a portable computing device.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANH C LE whose telephone number is 703-306-0542. The examiner can normally be reached on 8:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WILLIAM TROST can be reached on 703-308-5318. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



Danh C.Le
April 27, 2003



WILLIAM TROST
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